

Application No.: 10/726,618
Attorney Docket No. 52493.000310

REMARKS

The Office Action has been received and carefully considered. Claims 1-18 are pending in the present patent application. In this response, claims 9-12 and 17 are amended.

No new matter has been introduced by this Amendment.

Reconsideration of the current rejections in the present application is respectfully requested based on the following remarks.

A. The 35 U.S.C. 101 Rejection

In the Office Action, claims 9-12 are rejected under 35 U.S.C. 101. The Office Action asserts the claimed invention is directed to non-statutory subject matter. The Office Action sets forth asserted basis for the 35 U.S.C. 101 rejection. In particular, the Office Action asserts:

As to Claims 9-12, independent Claim 9 recites a system with modules for identifying, assessing, and making a decision. This is considered to be software per se unless there is an apparatus as well that is capable of executing the software appropriately in order to provide functionality. Claim 9 purports to be a systems claim, but **recite no clearly identifiable systems elements (such as a processor)**; rather, they are an "arrangement" performing functions. The claims do not clearly fall into a statutory category. Claims 10-12 are dependent claims and are rejected in a like manner.
(emphasis added)

(emphasis added)

In order to expedite prosecution of the present application, the rejected claims are amended, based on the comments in the Action, to more clearly recite statutory subject matter under 35 U.S.C. 101. In particular, the claims are amended to recite a "processor". Withdrawal of the 35 U.S.C. 101 rejection is requested.

B. The 35 U.S.C. 102 Rejection Based on DeTore

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DeTore et al. (Patent No.: 4,975,840). This rejection is respectfully traversed.

The features of claim 1 are set forth above.

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The Office Action asserts that DeTore teaches the various claimed features. In particular, the Office Action alleges that DeTore teaches:

assessing a consistency between the medication information and the medical condition information, the assessing a consistency between the medication information and the medical condition information performed by the processor (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36); and

making at least one insurance underwriting decision based on the **consistency** between the medication information and the medical condition information (see at least Figure 1; Col. 3, line 63 through Col. 6, line 8; Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36).

(emphasis added)

Applicant submits that DeTore fails to support the assertions set forth in the Office Action. Illustratively, DeTore describes (at column 5, lines 40 - column 6, line 9, as referenced in the Office Action):

For purposes of this discussion, the term "problem" will generally mean an element of information (e.g., facts and conditions such as age, a medical condition, a hazardous avocation, a smoking or drinking habit, etc.) stored in application data base 20 which impacts either positively or negatively upon the relative mortality of the proposed insured. The term "impairment" will generally mean an element of information (e.g., the impacts of aging, various medical conditions, avocations, smoking, drinking, etc. on the mortality of known populations) stored in underwriting knowledge base 24 **which relates to or corresponds with the information contained in application data base 20**. Each impairment is **associated** with textual information and/or an expert system or module which is intended to assist the system operator in quantifying the impact of a particular problem (by reference to a **corresponding** impairment) upon expected mortality in a particular instance. In broad terms, the approach to evaluating or underwriting a given risk which is incorporated into the process of the present invention includes the following steps:

1. Identifying a problem from the information contained in application data base 20;
2. **Matching or correlating the identified problem with a corresponding impairment from underwriting data base 24;**
3. Assigning weights (i.e., debits or credits) to the identified problems on the basis of information contained in the underwriting data base; and
4. Determining a risk classification for the given risk by combining the assigned weights.

As will be seen from the discussion which follows, the system of the present invention is capable of completing this process without the aid or intervention of skilled underwriters or other personnel in some cases and, in more difficult cases, is helpful in

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improving the efficiency, quality, and consistency of decisions which do require input from skilled underwriters.

(emphasis added)

Such teachings of DeTore are fundamentally different than the claimed features. That is, claim 1 recites "assessing a consistency between the medication information and the medical condition information ..." DeTore's teaching set forth above simply does not assess the consistency of factors, so as to teach the claimed invention. Rather, as set forth above, DeTore teaches matching or correlating the identified problem with a corresponding impairment. Such processing is simply different vis-à-vis the claimed "assessing a consistency."

To explain further, in regards to DeTore's teaching, the matching or correlating of DeTore is of the likes of a mapping process, i.e., an identified problem is mapped to a corresponding impairment. In contrast, the claimed invention relates to a comparison and not a mapping. In other words, the parameters of DeTore may be correlated even though it does not make sense to say that such two parameters are "consistent." Applicant submits that such highlights the distinction between the two concepts.

Further, claim 1 does not generally recite assessing a consistency between factors, but rather recites assessing a consistency between two specific factors, i.e., medication information vis-à vis medical condition information. DeTore provides no such teaching. For example, DeTore's chart of column 10, lines 42-55, fails to describe such particulars.

Applicant submits that claim 1 distinguishes over DeTore at least for the reasons set forth above.

The Office Action sets forth further comments regarding the rejection in the

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"Response to arguments and amendments" on page 2 of the Action. Therein, the Office Action asserts:

As to the rejection of claims 9-12 under 35 U.S.C. § 103, Applicant's amendments do not fully address the rejection which is thereby maintained as detailed below. As to the rejection of claims 1-16 under 35 U.S.C. § 102, Applicant's arguments have been fully considered but are not persuasive. Applicant argues that the prior art does not teach "assessing a consistency between the medication information and the medical condition". Examiner disagrees. Examiner cited Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36 of DeTore as teaching this limitation. Specifically, in **Col. 11, lines 7-23**, DeTore teaches an **"information interpretation expert module" which assesses the patient's medical problem or impairment in relation to medications used for particular impairments information**. The dependent claims are argued to be allowable for their dependence on claim 1. Examiner maintains that the rejection is proper.

(emphasis added)

Applicant respectfully submits that such remarks indeed further reveal the deficiencies of the rejection. Applicant submits that DeTore does teach "evaluation" of information. However, DeTore fails to disclose the "assessing a consistency" as recited in claim 1. Relatedly, DeTore fails to teach the related "comparing" features as recited in claim 17 (and rejected below under 35 U.S.C. 103).

The relied upon section of DeTore sets forth:

In this process, basic applicant data such as sex, age, height, weight, and the subject problem or impairment are combined with other data from underwriting knowledge base 24, such as symptoms, medical problems, **medications** used for particular impairments, laboratory test standards, other related impairments, and primary body functions affected. This information is **evaluated** by the information interpretation expert module which functions in the same manner as an expert diagnostic tool and is based on expertise which would normally be available only from highly skilled professionals. After **evaluating** this information, the information interpretation expert module makes a recommendation as to the most likely impairment(s) to underwrite. The underwriter is then prompted for agreement or disagreement with the subject recommendations (block 78).

(emphasis added)

Accordingly, as noted above, such teachings do relate to "evaluation." However, the concept of evaluating is fundamentally different than the concept of assessing a consistency, i.e.,

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"comparing". One can evaluate data without performing a comparison between the data. Indeed, data in evaluations may not even lend themselves to comparison. Applicant submits that such differences reflect fundamentally different processing of the claimed invention vis-à-vis the teachings of DeTore.

Further, the Office Action (as set forth above) asserts that DeTore teaches an information interpretation expert module which assesses the patient's medical problem or impairment in **relation** to medications used for particular impairments information (emphasis added). Applicant traverses that DeTore indeed provides such teaching. Applicant submits that such teaching of DeTore is a mischaracterization of DeTore's teaching of evaluating the data. Applicant respectfully submits that such mischaracterization sounds of DeTore's teaching being more relevant that it in fact is vis-à-vis the claimed invention.

Regarding claims 5, 9, and 13, these claims recite subject matter related to claim 1. Thus, at least some of the arguments set forth above with respect to claim 1 are equally applicable to claims 5, 9, and 13. Accordingly, it is respectfully submitted that such claims are allowable over DeTore for the same reasons as set forth above with respect to claim 1. While rejected below under 35 U.S.C. 103, Applicant submits that claim 17 is also allowable for similar reasons.

The various dependent claims should also be allowable at least by virtue of their respective dependency on the independent claims. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of the claims be withdrawn.

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C. The 35 U.S.C. 103 Rejection

In the Office Action, claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeTore et al. (Patent No.: 4,975,840), and further in view of the publication by McMillan et al. (Publication No.: US 2004/0039710). The rejection is traversed.

As set forth in the Office Action, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) include:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

It is respectfully submitted that the obviousness rejection of claims 17 and 18 is moot in view of the deficiencies of the applied art (i.e., DeTore) as discussed above.

That is, Applicant submits that the modification of DeTore based on the teachings of McMillan fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify DeTore based on the teachings of McMillan as asserted in the Office Action, which is not admitted by Applicant, such combination of applied art would still fail to fairly teach or suggest the claimed invention. Further, Applicant submits that such dependent claims recite patentable subject matter for at least reasons similar to those set forth above, as well as the additional features such dependent claims recite.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection under 35 U.S.C. 103 be withdrawn.

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D. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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